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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/360,069	07/23/1999	PETER WOHL	SNSY-A1998-0	3639

35273 7590 06/16/2004

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EXAMINER

GARCIA OTERO, EDUARDO

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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NOTICE OF NON-RESPONSIVE AMENDMENT: Bona Fide Attempt

Introduction

1. Title is: METHOD AND SYSTEM FOR GENERATING AN ATPG MODEL OF A MEMORY FROM BEHAVIORAL DESCRIPTIONS
2. First named inventor is: WOHL
3. Applicant's noncompliant Amendment was received 4/5/2004, and a compliant Amendment listing all claims was received 4/25/2004. Said Amendments are nonresponsive.
4. The US application was filed 7/23/2004.

Nonresponsive regarding 35 USC 102(f), Bona Fide

5. The replies filed on 4/5/2004 and 4/25/2004 are not fully responsive to the prior Office Action because of the following omission(s) or matter(s). Specifically, Applicant has not addressed the 35 USC 102(f) rejection of all pending claims, at paragraphs 27-29 of the prior office action. Said rejection stated "There is reason to question the list of inventors in the present application. Specifically, the publication "Using Verilog Simulation Libraries for ATPG", 0-7803-5753-1/99 1999 IEEE, is co-authored by Peter Wohl, and John Waicukauski. The present application lists three inventors: Peter Wohl, John Waicukauski, and Timothy G. Hunkler. Note that Timothy G. Hunkler is not a co-author of said publication. Thus, all of the present claims appear to be disclosed by said paper, as discussed in the 35 USC 102(a) rejections below."
6. Applicant's Remarks (received 4/5/2004) page 8 states "article cited in the Office Action and written by the inventors of the present application". This statement is not fully accurate. The article appears to be written by only 2 of the 3 named inventors. This inconsistency between 3 named inventors and 2 published authors causes a rejection under 35 USC 102(f). The omission of Timothy G. Hunkler from the published paper creates a substantial question of inventorship. Specifically, if Timothy G. Hunkler is an inventor, then why is his name omitted from the publication which appears to disclose all of the claims?
7. As an indirectly related matter, note that Applicant persuasively asserts that said publication was published after the instant application was filed, and therefore is not valid prior art for rejections under 35 USC 102(a). Specifically, said publication was published on "Publication Date: 28-30 Sept. 1999" according to IEEE.

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8. However, even if said publication is not prior art, the 35 USC 102(f) rejections remain valid. See MPEP 2137 which states "35 USC 102(f) may apply where 35 USC 102(a) and 35 USC 102(e) are not available statutory grounds for rejections".

9. MPEP 2137.01 states:

The definition for inventorship can be simply stated: "The threshold question in determining inventorship is who conceived the invention. Unless a person contributes to the conception of the invention, he is not an inventor. ... Insofar as defining an inventor is concerned, reduction to practice, per se, is irrelevant [except for simultaneous conception and reduction to practice, *Fiers v. Revel*, 984 F.2d 1164, 1168, 25 USPQ2d 1601, 1604-05 (Fed. Cir. 1993)]. One must contribute to the conception to be an inventor." In re Hardee, 223 USPQ 1122, 1123 (Comm'r Pat. 1984). See also Ex parte Smernoff, 215 USPQ 545, 547 (Bd. App. 1982) ("one who suggests an idea of a result to be accomplished, rather than the means of accomplishing it, is not an coinventor"). See MPEP § 2138.04 - § 2138.05 for a discussion of what evidence is required to establish conception or reduction to practice.

10. MPEP 2137.01 also states:

The inventive entity for a particular application is based on some contribution to at least one of the claims made by each of the named inventors. "Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent." 35 U.S.C. 116. "[T]he statute neither states nor implies that two inventors can be joint inventors' if they have had no contact whatsoever and are completely unaware of each other's work." What is required is some "quantum of collaboration or connection." In other words, "[f]or persons to be joint inventors under Section 116, there must be some element of joint behavior, such as collaboration or working under common direction, one inventor seeing a relevant report and building upon it or hearing another's suggestion at a meeting." *Kimberly-Clark Corp. v. Procter & Gamble Distrib. Co.*, 973 F.2d 911, 916-17, 23 USPQ2d 1921, 1925-26 (Fed. Cir. 1992); *Moler v. Purdy*, 131 USPQ 276, 279 (Bd. Pat. Inter. 1960) ("it is not necessary that the inventive concept come to both [joint inventors] at the same time").

Each joint inventor must generally contribute to the conception of the invention. A coinventor need not make a contribution to every claim of a patent. A contribution to one claim is enough. "The contributor of any disclosed means of a means-plus-function claim element is a joint inventor as to that claim, unless one asserting sole inventorship can

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show that the contribution of that means was simply a reduction to practice of the sole inventor's broader concept." *Ethicon Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1460-63, 45 USPQ2d 1545, 1548-1551 (Fed. Cir. 1998) (The electronics technician who contributed to one of the two alternative structures in the specification to define "the means for detaining" in a claim limitation was held to be a joint inventor.).

11. Additionally, note that the very related publication "Defining ATPG Rules Checking in STIL" by Peter Wohl and John Waicukauski was published in 1998 by IEEE, Paper 38.2 from the 1998 International Test Conference, 0-7803-5092-8/98 \$10.00 (c) 1998 IEEE. In view of the fact the Peter Wohl and John Waicukauski are the only two authors in a very related paper one year before filing the instant application, and are also the only two authors in a paper disclosing the claimed invention a few months after the instant application, this creates a very substantial doubt regarding whether Timothy G. Hunkler is properly an inventor of the instant application. Please address the inconsistency between the instant application and both of the above publications.

12. Similarly, Peter Wohl and John Waicukauski are also the only two authors in ATPG related publications in 1997 and 1996, already of record in the prosecution history.

13. **Applicant's reply is not responsive because it does not directly address the 35 USC 102(f) rejections.**

14. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1:136(a).**

Communication

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo Garcia-Otero whose telephone number is 703-305-0857. The examiner can normally be reached on Tuesday through Friday from 9:00 AM to 8:00 PM. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kevin Teska, can be reached at (703) 305-9704. The fax phone number for this group is 703-872-9306. Any inquiry of a general nature or relating to the status of this

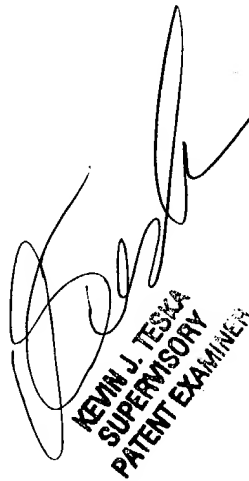
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application or proceeding should be directed to the group receptionist, whose telephone number is (703) 305-3900.

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KEVIN J. TESKA
SUPERVISORY
PATENT EXAMINER

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